

C. Remarks/Argument:

Applicants acknowledge with appreciation the withdrawal of the previous rejections based on novelty and double patenting.

Reconsideration of this application in view of the current rejections is respectfully requested. Upon entry of the amendments new claims 29-41 will be pending. Claims 20-28 have been canceled herein without prejudice or disclaimer to being pursued in this or a later filed application. Support for new claims 29-41 is found throughout the specification and claims as filed, or as previously presented. No new matter is believed added.

Rejection under 35 U.S.C. § 103(a)

The Examiner rejects claims 20-28 as obvious in view of U.S. Patent No. 5,889,126 to Kaplan et al. ("Kaplan") in combination with U.S. Patent No. 6,635,721 to Moens et al. ("Moens"). See Office Action at page 2. According to the Examiner, "it would have been obvious to a person of ordinary skill in the art [at the time of invention] to use Moens's amorphous polymer in Kaplan's applications in order to achieve good mechanical properties and excellent weatherability." See Office Action at page 6.

Claims 20-28 have been canceled herewith. Accordingly, the rejection is moot and should be withdrawn as applied to these claims. Applicants traverse the rejection as applied to new claims 29-41 presented herewith.

A clear reading of Applicants' application indicates that the present invention is directed to isophthalic acid-rich polyesters that have outstanding outdoor durability and flexibility with excellent degassing properties, such that outdoor resistance of the compositions of the claimed invention is equal to or greater than those polyester compositions that are currently commercially

available, which suffer from (among other things) bubble formation due to degassing problems.

See U.S. Publication No. 2006/0217520 at paragraphs [0011] - [0017].

Independent claim 29, from which all other claims directly or indirectly depend, recites:

A powdered thermosetting composition comprising:

a) a carboxyl functional amorphous polyester having an acid number from 12 to 34 mg KOH/g,

wherein the polyester is prepared from:

i) a polyacid constituent comprising from 81 to 100% mole of isophthalic acid (IPA); and

ii) a polyol constituent comprising from 15 to 65% mole of one or more linear chain aliphatic C₄-C₁₆ diol, and from 35 to 85% mole of neopentyl glycol (NPG);

and

b) a cross-linking agent comprising at least two β -hydroxyalkylamide groups,

with the proviso that said powdered thermosetting compositions do not contain semi-crystalline polyesters.
(emphasis added)

Although Kaplan discloses *co*-polyesters of amorphous and/or semi-crystalline nature having β -HAA groups, Applicant submits that the reference is not enabling for (*i.e.*, does not teach) an isophthalic-rich carboxyl functional amorphous polyester as required by the claimed invention. Only Example 3 of Kaplan relates to a carboxy-functional amorphous polyester. However, this example teaches a *terephthalic* acid-rich polyester. Isophthalic acid is only present at 10 % mole.

While Kaplan provides a laundry list of suitable alcohol components ranging from C₂-C₂₀, the linear chain aliphatic C₄-C₁₆ diols are not especially highlighted for use in addition to NPG nor is the concentration in which they should be used disclosed.

Finally, Examples 4-6 of Kaplan make clear that the carboxyl-functional copolyester of its invention is provided as the resin component and blended with the *semi-crystalline, hydroxyl-*

functional copolyesters of Examples 1 and 2, which act as the hardening component. In stark contrast, the claimed invention recites a carboxyl-functional polyester containing no semi-crystalline polyester. Thus, to modify Kaplan in the manner suggested by the Examiner would be to change the principle of operation of Kaplan. MPEP § 2143.01, part VI makes clear that if a proposed modification changes the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious.

More importantly, and notwithstanding the above, the combination of Kaplan and Moens cannot be supported to sustain a rejection based on 35 USC § 103(a). Moens clearly teaches a thermosetting powder composition comprising i) a mixture of polyesters and ii) a cross-linking agent. See Moens at Abstract. A closer reading makes clear that this mixture of polyesters necessarily includes a semi-crystalline polyester from 5 to 45 parts by weight. See *id.*; see also col. 8, lines 52-57; col. 19, lines 1-17; and claim 1.

Thus, Moens clearly teaches away from the claimed invention, which explicitly makes clear that the recited powdered thermosetting compositions do not contain any semi-crystalline polyester. That Moens may teach an amorphous polyester that may fall within the scope of the claimed invention, or that Moens may teach how to make such a polyester, is irrelevant. It is a basic tenet of patent law that the prior art must be considered as a whole for that which it teaches, including the portions that lead away from the claimed invention. See MPEP § 2141.02, part VI. It is improper of the Examiner or the Office to pick and choose some of the teachings to achieve the claimed invention while ignoring the teachings in their entirety, as this amounts to a hindsight reconstruction of Applicants' claimed invention. Here, Moens teaches in all its embodiments that the polyester portion of its compositions must contain semi-crystalline

polyester. Accordingly, one of skill in the art at the time of invention would not have relied on the teachings of Moens to achieve the claimed invention. Therefore, the combination of Kaplan and Moens cannot be sustained.

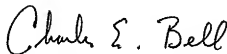
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejection.

Conclusion

Applicants submit that this paper is fully responsive and that the application is in condition for allowance. Such action is respectfully requested. Should any questions or issues arise concerning the application, the Examiner is encouraged to contact the undersigned at the telephone number provided below. The undersigned has been authorized to correspond with the Office on behalf of Applicants in a representative capacity pursuant to 37 CFR § 1.34.

An RCE and payment of the corresponding fee are concurrently filed herewith. With a two-month extension of time and payment of the corresponding fee, this response is due on or before April 20, 2009. The Commissioner is hereby authorized to charge payment of any additional fees that may be required, or credit any overpayment of same, to Deposit Account No. 03-4083.

Respectfully submitted,



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